

REMARKS

This application contains claims 1-134, the status of which is as follows:

- (a) Claims 111, 121-123, and 125 have been currently amended.
- (b) Claims 40, 44-52 and 65-70 are as originally filed.
- (c) Claims 1-34, 55, and 71-72 have been canceled without prejudice.
- (d) Claims 35-39, 41-43, 53-54, 56-64, 73-110, 112-120, 124, and 126-134 were previously presented.

No new matter has been added. Reconsideration is respectfully requested.

Applicant thanks Examiners Bockelman and Layno for the courtesy of a personal interview with Applicant's representatives, Sanford T. Colb (Reg. No. 26,856) and Daniel M. Goldstein (Reg. No. 44,127), who participated telephonically, and one of the inventors, Shai Ayal, held in the USPTO on June 5, 2007. At the interview, Mr. Colb and Dr. Goldstein argued the patentability of claims 35, 111, 121, and 125 under 35 U.S.C. 112, first paragraph. The Examiners agreed that claim 35 was mistakenly rejected under 35 U.S.C. 112, first paragraph, because the term "antidromic" does not appear in the claim. The Examiners further agreed that claims 111, 121, and 125 would be patentable under 35 U.S.C. 112, first paragraph, if amended to remove the term "antidromic," because the Applicant has support for stimulating nervous tissue in a first direction (orthodromic) and blocking action potentials in a second, opposite direction. Examiner Bockelman will review the art of record and update the search for claims 35, 111, 121, and 125.

Claim rejections under 35 U.S.C. 112

Claims 35-54 and 56-134 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. As mentioned above, during the interview with Mr. Colb, Dr. Goldstein, and Dr. Ayal, the Examiners agreed that the rejection of claim 35 was

improper, and that the rejections of claims 111, 121, and 125 would be withdrawn if the Applicant amends these claims to remove the term "antidromic," which, according to the Examiners, does not find support in the specification as filed. Although the Applicant continues to believe that "antidromic" is supported in the specification as filed, in order to expedite issuance of a patent, the Applicant has amended claims 111, 121, and 125 as suggested by the Examiners, but reserves the right to prosecute claims in daughter applications relating to inhibiting antidromic action potentials. (The Applicant has also amended claims 122 and 123 to provide proper antecedent basis in light of the amendments to claim 121.) As mentioned in the Applicant's previous response to the office action dated April 7, 2006, support for the term "orthodromic" was previously provided in a response filed August 12, 2003 in the parent application (Application No. 09/944,913). The Applicant therefore respectfully submits that claims 35-54, 56-70, and 73-134 are patentable under 35 U.S.C. 112, first paragraph.

Double patenting rejections

Claims 34-54 and 56-86 were rejected on the ground of non-statutory obviousness-type double patenting over claim 21 of US Patent 6,684,105. Claims 87-134 were rejected on the ground of non-statutory obviousness-type double patenting over the claims of US Patent 6,684,105 in view of US Patent 5,215,086 to Terry, Jr. et al. Although not necessarily agreeing with these rejections, the Applicant is filing a terminal disclaimer with respect to the '105 patent in order to expedite the issuance of a patent.

The Applicant believes the amendments and remarks presented hereinabove, and the filing of the terminal disclaimer, to be fully responsive to all of the grounds of rejection raised by the Examiner. In view of these amendments and remarks, the Applicant respectfully submits that all of

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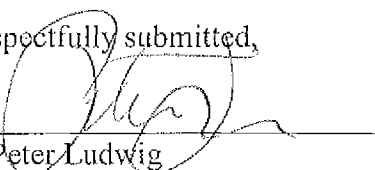
Docket No.: 06727/100J782-US5

the claims in the present application are now in order for allowance. Notice to this effect is respectfully requested.

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Respectfully submitted,

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